

### **REMARKS**

Claims 128-138, 202-205, and 339-344 are pending in the application. Claims 137, 202-205, and 339-344 have been allowed. Claims 128 and 138 have been amended. No new matter has been added.

### **Rejections Under 35 U.S.C. §102 and §103**

Claims 128-136 and 138 stand rejected under 35 U.S.C. 102(b) and 103(a) as being anticipated or obvious in view of International Publication No. WO 96/03087 to Dubach et al. ("Dubach").

#### **Independent Claim 128**

Claim 128 recites,

*A method for locating a preferred positioning for a prosthesis in a target implant location, comprising:*

- (a) surgically exposing a skeletal joint;*
- (b) locating a first plane within the target location in the transverse direction; and*
- (c) locating a second plane within the target location in the sagittal direction,*

*wherein the first and second planes intersect to define a line along which a preferred position for locating the prosthesis can be determined.*

Independent claim 128 has been rejected under §102(b) as being anticipated by Dubach. The PTO provides in MPEP §2131 that "[t]o anticipate a claim, the reference must teach every element of the claim." Therefore, with respect to claim 128, to support a rejection under 35 U.S.C. §102(b), the Dubach reference must contain all of the above claimed elements of the claim as amended. Dubach does not, however, appear to teach "surgically exposing a skeletal joint," but rather is directed toward the "percutaneous localization of a foreign object" (Abstract). Therefore, claim 128 and dependent claims 129-136, which depend from and further limit claim

128, are deemed allowable over the Dubach reference.

Independent Claim 138

Claim 138 recites,

*A system for positioning instruments relative to a line during spinal surgery, comprising:*

*(a) a first instrument for determining a first point in a first plane and for indicating the position of the first point by marking a surgically exposed vertebral body;*

*(b) a second instrument adapted to be positioned relative to the mark for adapted for locating a second plane substantially perpendicular to the first plane, wherein the first and second planes intersect to form a line;*

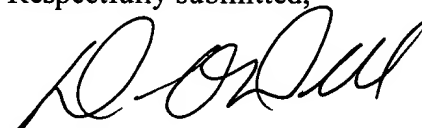
*(c) a fixture adapted to be temporarily affixed to a vertebral body such that it is collinear with the reference line, and adapted to position site preparation instruments relative the line.*

Independent claim 138 has been rejected under §102(b) as being anticipated by Dubach. The PTO provides in MPEP §2131 that “[t]o anticipate a claim, the reference must teach every element of the claim.” Therefore, with respect to claim 128 as amended, to support a rejection under 35 U.S.C. §102(b), the Dubach reference must contain all of the above claimed elements of the claim. Dubach does not, however, appear to teach “a surgically exposed vertebral body,” but rather is directed toward the “percutaneous localization of a foreign object” (Abstract). Therefore, claim 138 is deemed allowable over the Dubach reference.

**Conclusion**

Therefore, it is respectfully submitted that independent claims 128 and 138 are in condition for allowance. Dependent claims 129-136 depend from and further limit independent claims 128, and therefore are allowable as well. Should the Examiner deem that any further amendment is desirable to place this application in condition for allowance, the Examiner is invited to telephone the undersigned at the below listed telephone number.

Respectfully submitted,



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